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Filing date: **06/07/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

| | | | |
|---------|--------------------------------------------------------------|-------------|------------|
| Name | W.S. Industries, Inc. | | |
| Entity | Corporation | Citizenship | California |
| Address | 7375 Chapman Ave. Garden Grove, CA 92841 UNITED STATES | | |

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|----------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Attorney information | Andrew S. Flior Snell & Wilmer LLP 600 Anton Blvd., Ste. 1400 Costa Mesa, CA 92626 UNITED STATES aflior@swlaw.com, ipocdocket@swlaw.com Phone:714-427-7083 |
|----------------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

Registration Subject to Cancellation

| | | | |
|-----------------|-------------------------------------------------------------------------------------|-------------------|------------|
| Registration No | 3973270 | Registration date | 06/07/2011 |
| Registrant | Huynh, Kevin B 3804 Carnation Street Franklin Park, IL 60131 UNITED STATES | | |

Goods/Services Subject to Cancellation

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| Class 008. First Use: 2010/07/01 First Use In Commerce: 2010/07/01 All goods and services in the class are cancelled, namely: Manicure implements, namely, nail files; Nail buffers; Nail files; Pedicure implements, namely, nail files |
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Grounds for Cancellation

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|------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------|
| Priority and likelihood of confusion | Trademark Act Sections 14(1) and 2(d) |
| The mark is merely descriptive | Trademark Act Sections 14(1) and 2(e)(1) |
| The mark is deceptively misdescriptive | Trademark Act Sections 14(1) and 2(e)(1) |
| The mark is primarily geographically descriptive | Trademark Act Sections 14(1) and 2(e)(2) |
| The mark is primarily geographically deceptively misdescriptive | Trademark Act Sections 14(1) and 2(e)(3) |
| Registrant not rightful owner of mark for identified goods or services | Trademark Act Sections 14(1) and 1 |
| Fraud on the USPTO | Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) |

Mark Cited by Petitioner as Basis for Cancellation

| | | | |
|------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|------------------|------|
| U.S. Application/ Registration No. | NONE | Application Date | NONE |
| Registration Date | NONE | | |
| Word Mark | PRO-TOOL | | |
| Goods/Services | manicure and pedicure implements, namely, nail filing bits, nail filing hand pieces and systems, foot controls for the nail filing hand pieces, connector shafts for the nail filing hand pieces, and callus removers | | |

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| Attachments | PetCan.pdf(325532 bytes) Exhibit.pdf(31919 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|-------------------|
| Signature | /Andrew S. Flior/ |
| Name | Andrew S. Flior |
| Date | 06/07/2016 |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 3,973,270
Mark: ProTool USA

W.S. Industries, Inc., a California
corporation,

Petitioner,

v.

Kevin B. Huynh, an individual,

Registrant.

Cancellation No.: _____

PETITION TO CANCEL

W.S. Industries, Inc., a California corporation, with its principal place of business at 7375 Chapman Ave., Garden Grove, California 92841 (“Petitioner”), believes and alleges that it will be damaged by the continued registration of U.S. Trademark Registration No. 3,973,270 (“Registration”) (attached as Exhibit A), owned by Kevin B. Huynh, an individual having United States citizenship, with an address of 3804 Carnation Street, Franklin Park, Illinois 60131 (“Registrant”), for the trademark ProTool USA in connection with “Manicure implements, namely, nail files; nail buffers; nail files; pedicure implements, namely, nail files” in International Class 8, and hereby petitions to cancel the same.

As grounds for cancellation, Petitioner asserts as follows:

1. Registrant’s application for its Registration was filed on August 18, 2010 and the resulting Registration claims a first use and a first use in commerce of July 1, 2010 for the trademark ProTool USA for the goods of: manicure implements, namely, nail files; nail buffers; nail files; pedicure implements, namely, nail files.

2. For many years and since long prior to the filing date of Registrant's application for its Registration and any date of first use on which Registrant can rely, Petitioner adopted and has continuously used in commerce and has not abandoned in the United States, the trademark PRO-TOOL as a trademark for goods including: manicure and pedicure implements, namely, nail filing bits, nail filing hand pieces and systems, foot controls for the nail filing hand pieces, connector shafts for the nail filing hand pieces, and callus removers.

3. For many years and since long prior to the filing date of Registrant's application for its Registration and any date of first use on which Registrant can rely, Petitioner has established trademark rights and significant goodwill in the trademark PRO-TOOL as used for goods including: manicure and pedicure implements, namely, nail filing bits, nail filing hand pieces and systems, foot controls for the nail filing hand pieces, connector shafts for the nail filing hand pieces, and callus removers.

4. Since at least as early as 1999, Petitioner has continuously used in commerce and has not abandoned in the United States, the trademark PRO-TOOL as a trademark for goods including: manicure and pedicure implements, namely, nail filing hand pieces, foot controls for the nail filing hand pieces, and connector shafts for the nail filing hand pieces.

5. Since at least as early as 2003, Petitioner has continuously used in commerce and has not abandoned in the United States, the trademark PRO-TOOL as a trademark for goods including: manicure and pedicure implements, namely, nail filing bits, and nail filing systems.

6. Since at least as early as 2007, Petitioner has continuously used in commerce and has not abandoned in the United States, the trademark PRO-TOOL as a trademark for goods including: pedicure implements, namely, callus removers.

7. Petitioner has priority of use over Registrant for the trademark PRO-TOOL in connection with goods including: manicure and pedicure implements, namely, nail filing bits, nail filing hand pieces and systems, foot controls for the nail filing hand pieces, connector shafts for the nail filing hand pieces, and callus removers.

8. The ProTool USA trademark is confusingly similar to Petitioner's previously used PRO-TOOL trademark, and the Registration lists goods that are substantially similar or identical to the goods offered and sold by Petitioner in connection with the PRO-TOOL trademark, as to cause confusion, to cause mistake, or to deceive.

9. Registrant's ProTool USA trademark and Petitioner's previously used PRO-TOOL trademark are substantially similar in sight, sound, meaning, and overall commercial impression.

10. The goods offered and sold by Petitioner in connection with the PRO-TOOL trademark, and the goods listed in the Registration, are likely to be and are offered and rendered through the same channels of trade and purchased by the same class of purchasers.

11. Petitioner's customers, and the public in general, are likely to be and are confused, mistaken or deceived as to the origin, affiliation, endorsement or sponsorship of the goods that are sold and marked under Registrant's ProTool USA mark, and are likely to be and are misled into believing that such goods are produced by, offered by, sold by, emanate from or are in some way associated with Petitioner, to the damage and detriment to Petitioner and its reputation.

12. The Registration should be canceled on the ground that it is contrary to 15 U.S.C. § 1052(d) and violates and diminishes the prior and superior right of Petitioner to its PRO-TOOL trademark.

13. Petitioner alleges its trademark PRO-TOOL is inherently distinctive for the goods to which it is applied.

14. Alternatively, Petitioner alleges that, by reason of its extensive advertising and use of the trademark PRO-TOOL, the trademark achieved acquired distinctiveness under 15 U.S.C. § 1052(f) before Registrant's first use of the ProTool USA trademark.

15. In the event that the Board finds that the trademark PRO-TOOL is not inherently distinctive of Petitioner's goods, Petitioner alternatively alleges that Registrant's ProTool USA trademark is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, and/or primarily geographically deceptively misdescriptive of the goods listed in the Registration at the time of registration, and therefore the Registration should be canceled under one or more of 15 U.S.C. §§ 1052(e)(1), (e)(2), or (e)(3).

16. As an additional ground for cancellation of the Registration, the Petitioner alleges on information and belief that at the time Registrant filed its application for Registration on August 18, 2010, that Kevin B. Huynh was not the rightful owner of the registered mark, and therefore the Registration should be canceled. The Petitioner alleges on information and belief that on August 18, 2010 any alleged trademark rights resulting in the Registration, which Petitioner does not admit existed or exists, were held by the entity Skyline Beauty Supply, Inc., or Nail Superstore, Inc., or another entity not comprising Kevin B. Huynh, and therefore the Registration should be canceled as being in contravention of 15 U.S.C. § 1051(a).

17. As an additional ground for cancellation of the Registration, the Petitioner alleges on information and belief that currently Kevin B. Huynh is not the rightful owner of the registered mark, and therefore the Registration should be canceled. The Petitioner alleges on information and belief that any alleged trademark rights of the Registration, which Petitioner does not admit existed or exists, are held by the entity Skyline Beauty Supply, Inc., or Nail

Superstore, Inc., or another entity not comprising Kevin B. Huynh, and therefore the Registration should be canceled as being in contravention of 15 U.S.C. § 1051(a).

18. As an additional ground for cancelation of the Registration, the Petitioner alleges the Registrant and Registrant's Attorney committed fraud during the prosecution of the Registration, by submitting a false declaration in the application filed August 18, 2010 having serial number 85/110,474 that resulted in the Registration, that the Registrant and its Attorney "believes the applicant to be the owner of the trademark/service mark sought to be registered . . . to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true."

19. Said declaration was false and was filed with the knowledge and belief that said declaration was false in that the Registrant, and Registrant's Attorney on behalf of Registrant, in fact had knowledge that the Registrant was not "the owner of the trademark/service mark sought to be registered" and had knowledge that Petitioner "ha[d] the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive," which is a material misrepresentation that contravenes the requirements of 15 U.S.C. § 1051(a).

20. Registrant, and Registrant's Attorney on behalf of Registrant, had knowledge that Registrant was not "the owner of the trademark/service mark sought to be registered" and that Petitioner "ha[d] the right to use the mark in commerce, either in the

identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive,” because at the time application serial number 85/110,474 was filed on August 18, 2010, the Registrant had been a customer of Petitioner since 2003 and was aware of the trademarks of Petitioner and the goods sold thereunder, including Petitioner’s use of the PRO-TOOL trademark as used on goods identical or substantially similar to the goods listed in the Registrant’s application and the Registration. Registrant was aware of Petitioner’s use of the PRO-TOOL trademark in this manner due, at least in part, to Registrant’s receipt, access, and/or review of Petitioner’s product offerings and catalogs that included the trademark PRO-TOOL used on goods identical or substantially similar to the goods listed in the Registrant’s application and the Registration. Registrant filed for the ProTool USA trademark registration despite having knowledge that Petitioner was the owner of the PRO-TOOL trademark as used on goods identical or substantially similar to the goods listed in the Registrant’s application and the Registration.

21. Said declaration was filed with the intent to induce authorized agents of the United States Patent and Trademark Office to pass Registrant’s trademark to publication and to grant the Registration.

22. Reasonably relying upon the truth of said false declaration, the United States Patent and Trademark Office accepted said declaration and passed Registrant’s trademark application to publication and granted the Registration.

23. The Registration should be canceled, as it was procured upon this act of fraud towards the United States Patent and Trademark Office and the public, and would violate and diminish the prior and superior right of Petitioner to its PRO-TOOL trademark.

WHEREFORE, for the foregoing grounds, Petitioner prays that the Registration be canceled in its entirety, and that this cancellation be sustained in favor of Petitioner.

This Petition to Cancel is timely filed today with the Trademark Trial and Appeal Board within five years from the date of the Registration's issuance. As noted in the electronic filing to which the document is attached, the undersigned has authorized payment by deposit account of the filing fee of \$300.00 for canceling a registration in in one class in accordance with 37 C.F.R. § 2.6(a)(16).

Respectfully submitted,

SNELL & WILMER L.L.P.

Dated: June 7, 2016

By: /Andrew S. Flior/
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Attorney for Petitioner
W.S. Industries, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Petition to Cancel and attached Exhibit is being deposited in the United States mail, first class postage prepaid, to Registrant and to the individual believed to be Registrant's attorney of record, based on the records of the United States Patent and Trademark Office's Trademark Status & Document Retrieval (TSDR), at the addresses and on the date indicated below:

Kevin B. Huynh
3804 Carnation Street
Franklin Park, Illinois 60131

William P. Ellsworth
Jay Zabel & Associates, Ltd.
55 W. Monroe St., Ste. 3950
Chicago, Illinois 60603-5056

Date: June 7, 2016

By: /Andrew S. Flior/

EXHIBIT A

United States of America

United States Patent and Trademark Office

ProTool USA

Reg. No. 3,973,270

Registered June 7, 2011

Int. Cl.: 8

TRADEMARK

PRINCIPAL REGISTER

HUYNH, KEVIN B (UNITED STATES INDIVIDUAL)
3804 CARNATION STREET
FRANKLIN PARK, IL 60131

FOR: MANICURE IMPLEMENTS, NAMELY, NAIL FILES; NAIL BUFFERS; NAIL FILES;
PEDICURE IMPLEMENTS, NAMELY, NAIL FILES, IN CLASS 8 (U.S. CLS. 23, 28 AND 44).

FIRST USE 7-1-2010; IN COMMERCE 7-1-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "USA", APART FROM THE MARK AS SHOWN.

SER. NO. 85-110,474, FILED 8-18-2010.

CAROLINE WOOD, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office